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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,629	07/28/2006	Stefan Kuchenhoff	2004P01338WOUS	2653
29177	7590	01/08/2009	EXAMINER	
BELL, BOYD & LLOYD, LLP			CATTUNGAL, AJAY P	
P.O. BOX 1135			ART UNIT	PAPER NUMBER
CHICAGO, IL 60690			4173	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/587,629	KUCHENHOFF ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	AJAY P. CATTUNGAL	4173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 28 July 2006.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 10-23 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 10-23 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 28 July 2006 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                                                |                                                                   |
|------------------------------------------------------------------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                           | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>07/28/06 and 09/18/06</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|                                                                                                                                                | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 10, 11, 14-16, 18-19, 22-23 rejected under 35 U.S.C. 102 (b) as being unpatentable by Michael et al. (US 2003/0226143).

Re claim 10, Michael et al. teaches a method for distributing a short message (SMS) to a video user (subscriber operating a TV), comprising: sending the short message (SMS) to a short messages distribution center (CATV gateway); forwarding the message from the distribution center (CATV gateway) to a video control device (TV set-top box) that controls a service available to the video user; and forwarding the message from the video control device (set-top box) to a terminal (TV) of the video user (Para 41 lines 1-4, Para 43 lines 9-12, Para 44 lines 1-7).

Re claim 11, Michael et al. teaches a method, wherein an IP protocol (internet) is used in the forwarding the message between the video control device (set-top box) and the terminal (TV), and wherein the message is forwarded from the video control device (set-top box) to the terminal if the terminal (TV) is online (alert the appropriate TV subscriber) (Para 41 lines 1-4, Para 43 lines 9-12, Para 44 lines 1-7, and Para 47).

Re claim 14, Michael et al. teaches a method wherein the message is stored at the video control device if the terminal is offline (Para 48 line 19-23).

Re claim 15, Michael et al. teaches a method wherein the stored message is forwarded by video control device when the offline terminal goes online (Para 48 line 19-23).

Re claim 16, Michael et al. teaches a method wherein a PSTN call number is used as an address of the video user (Para 42 lines 7-9).

Re claim 18, Michael et al. teaches a video control device (TV set-top box) that controls a service available to a video user, a subscription mechanism that allows the video user (subscriber) to subscribe to a short message service (Para 2 lines 5-7); a registration mechanism for informing a distribution center (CATV gateway) of an address of the subscribed user (registered subscriber) (Para 57 lines 1-3) so that the distribution center(CATV gateway) forwards a message for the subscribed user to the video control device(TV set-top box); and a short message for the subscribed that is sent by the distribution center and forwarded to a terminal of the subscribed user (Para 41 lines 1-4, Para 43 lines 9-12, Para 44 lines 1-7).

Re claim 19, Michael et al. teaches a video device, wherein the user of the terminal is identified, and wherein the short message is forwarded to the terminal if the identified user is the video user(Para 49 lines 1-9).

Re claim 22, Michael et al. teaches a distribution center (CATV gateway) for short messages, comprising: a logon device (logon request unit) to which a video user can be logged on via a video control device (TV set-top box) that controls a service available to the video user (subscriber); an incoming message from a mobile radio network that are addressed to the logged-on user; and a distribution device (CATV

gateway) that forwards the message to the video control device (TV set-top box), wherein the logged-on user is not in the mobile radio network (Para 41 lines 1-4, Para 43 lines 9-12, Para 44 lines 1-7, Para 49 lines 4-8 and fig 1).

Re claim 23, Michael et al. teaches a distribution center, wherein the address is a PSTN call number (Para 42 lines 7-9).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 12, 13 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Michael et al. (US 2003/0226143) in view of Zhang et al. (US 2004/0111749).

Re claim 12, Michael et al. discloses the claimed invention as set forth in claim 11 above. Michael et al. does not disclose a method of receiving a short message from

the video user by the video control device; determining that a recipient of the message is not managed by the video control device; and forwarding the message to the distribution center. However Zhang et al. teaches a method of receiving a short Message (Demand short message) from the video user (user end) by the video control device (Receiving unit); determining that a recipient of the message is not managed by the video control device (Receiving Unit); and forwarding the message to the distribution center (program delivering end) (Para 18 and Para 24 lines 1-8). It would have been obvious to one having ordinary skill in the art at the time of the invention to use the messaging back system of Zhang et al. with the message receiving system of Michael et al. in order to have a bidirectional communication using a TV set-top box.

Re claim 13, Michael et al. discloses a method of forwarding (conveyed) the message (SMS message) to the recipient via an IP network (over the internet) and not by a mobile radio network (Para 46) along with the claimed invention as set forth in claim 11 above. Michael et al. does not disclose a method of receiving a short message from the video user by the video control device; determining that a recipient of the message is managed by the video control device. However Zhang et al. teaches a method of receiving a short message (short message) from the video user (user end) by the video control device (receiving unit); determining (extracting the user identifier) that a recipient of the message is managed by the video control device (Para 18 and Para 24 lines 1-8). It would have been obvious to one having ordinary skill in the art at the time of the invention to use the messaging back system of Zhang et al. with the

message receiving system of Michael et al. in order to have bidirectional communication using a TV set-top box.

Re claim 20, Michael et al. discloses the claimed invention as set forth in claim 19 above. Michael et al. does not disclose a video device, wherein a further user has not subscribed to the device, and wherein a short message originating from the subscribed user is sent to the further user by forwarding the message to the distribution center. However Zhang et al. teaches a video device, wherein a further user has not subscribed to the device, and wherein a short message (short message) originating from the subscribed user (user end) is sent to the further user by forwarding the message to the distribution center (program delivering end) (Para 18 and Para 24 lines 1-8). It would have been obvious to one having ordinary skill in the art at the time of the invention to use the messaging back system of Zhang et al. with the message receiving system of Michael et al. in order to have a bidirectional communication using a TV set-top box.

6. Claims 17 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Michael et al. (US 2003/0226143) in view of Setoyama et al. ( US 6,188,684).

Re claim 17, Michael et al. discloses the claimed invention as set forth in claim 11 above. Michael et al. does not disclose a method wherein an IP address or a URI is used as an address of the video user. However Setoyama et al. teaches a method wherein an IP address or a URI is used as an address of the video user (Col 8, lines 10-14). It would have been obvious to one having ordinary skill in the art at the time of the invention to use the IP address for the set-top box of Setoyama et al. with the

message receiving system of Michael et al. in order to have a bidirectional communication system using set-top box.

Re claim 21, Michael et al. discloses the claimed invention as set forth in claim 11 above. Michael et al. does not disclose a video device, wherein when a plurality of users have subscribed to the device including a first user and a second user, the device acts as a distribution center, and wherein a short message originating from the first user is sent to the second user via an IP network and without entering the mobile radio network. However Setoyama et al. teaches a video device, wherein when a plurality of users (one or more) have subscribed to the device including a first user (first communication station) and a second user (second communication station), the device acts as a distribution center (communication link), and wherein a short message originating from the first user (first communication station) is sent to the second user (second communication station) via an IP network (dial up link) and without entering the mobile radio network (Col 4 lines 1-9, and fig 1). It would have been obvious to one having ordinary skill in the art at the time of the invention to use the plurality of users communicating via dial up link of Setoyama et al. with the message receiving system of Michael et al. in order to have a bidirectional communication system using set-top box.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AJAY P. CATTUNGAL whose telephone number is (571)270-7525. The examiner can normally be reached on Monday- Friday 7:30 - 5:00, Alternating Fridays OFF.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jinhee Lee can be reached on 571-292-1977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. P. C./  
Examiner, Art Unit 4173

/Jinhee J Lee/  
Supervisory Patent Examiner, Art Unit 4173